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In re Application of :  
SHI et al. : DECISION  
Application No.: 09/701,309 :  
PCT No.: PCT/JP00/01754 :  
Int. Filing Date: 23 March 2000 :  
Priority Date: 31 March 1999 :  
Attorney's Docket No.: L9289.00120 :  
For: COMMUNICATION TERMINAL :  
APPARATUS, BASE STATION APPARATUS :  
AND RADIO COMMUNICATION METHOD :  
:

This is a decision in response to applicants' "REQUEST FOR CORRECTED FILING RECEIPT" filed 17 April 2002.

#### BACKGROUND

On 23 March 2000, applicants filed international application PCT/JP00/01754, which claimed a priority date of 31 March 1999. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 12 October 2000. The twenty-month period for paying the basic national fee in the United States expired at midnight on 31 November 2000.

On 28 November 2000, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee and the surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than twenty months from the priority date.

On 26 December 2000, the USPTO mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) was required. The NOTIFICATION set a one-month extendable period for reply.

On 26 March 2001, applicants submitted a petition under 37 CFR 1.47(a), which was accompanied by, *inter alia*: a petition/fee for a two-month extension of time; surcharge under 37 CFR 1.492(e); an authorization to charge any fees which may be required to Deposit Account 19-4375; a declaration of inventors executed by two of the three joint inventors; a declaration of facts

by Osamu Kato; cover letters of mailings sent to Mr. Shi on 08 February 2001 and 16 February 2001; and translations of Registered Record of Delivery for these mailings which indicate that these mailings were returned to the sender after a one-week custodial period due to absence of the recipient.

On 21 August 2001, the USPTO mailed a decision dismissing applicants' petition under 37 CFR 1.47(a). Specifically, it was noted that sufficient factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort was not provided.

On 19 October 2001, applicants submitted a "RENEWED PETITION UNDER 37 CFR §1.47(a)", which was accompanied by, *inter alia*, a supplemental declaration of facts of Osamu Kato, a registered mail receipt (with English translation) for a delivery made to Mr. Shi on 17 September 2001, a "Record of Delivery" (with English translation) for recipient Mr. Shi, and a sample "Notice of Delivery" (with English translation).

On 08 March 2002, the USPTO mailed a decision granting applicants' renewed petition under 37 CFR 1.47(a).

On 14 March 2002, the USPTO mailed a NOTIFICATION OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 (Form PCT/DO/EO/903) according a 371(c) date of 26 March 2001.

On 17 April 2002, applicants submitted the instant "REQUEST FOR CORRECTED FILING RECEIPT" requesting that the title be changed and that the filing date be changed from 26 March 2001 to 28 November 2000.

## DISCUSSION

Regarding applicant's request to change the filing date, attention is directed to MPEP § 1893.03(b), which states:

An international application designating the U.S. has two stages (international and national) with the filing date being the same in both stages. Often the date of entry into the national stage is confused with the filing date. It should be borne in mind that the filing date of the international stage application is also the filing date for the national stage application. Specifically, 35 U.S.C. 363 provides that

An international application designating the United States shall have the effect, from its international filing date under Article 11 of the treaty, of a national application for patent regularly filed in the Patent and Trademark Office except as otherwise provided in section 102(e) of this title.

Similarly, PCT Article 11(3) provides that

...an international filing date shall have the effect of a regular national application in each designated State as of the international filing date, which date shall be considered to be the actual filing date in each designated State.

37 CFR 1.496(a), first sentence, reads "International applications which have complied with the requirements of 35 U.S.C. 371(c) will be taken up for action based on the date on which such requirements were met." Thus, when the file wrapper label or PALM bib-data sheet is printed, the information is read from the PALM data base and the information printed in the filing date box is the date of entry into the national stage rather than the actual international filing date. See in the preceding section the sample National Stage Filing Under 35 U.S.C. 371 wherein the face of the file of national stage application number 07/XXX,XXX is shown with the date of entry into the national stage (11/08/91) shown in the FILING DATE box and the true U.S. filing date (01/10/90) is indicated just to the right of the international application number (PCT/EP90/XXXXX) in the FOREIGN/PCT APPLICATIONS block.

Applicants are quite often confused as to the true filing date and will ask for corrected filing receipts thinking that the information thereon is wrong. This explanation should offer some clarity. For all legal purposes, the filing date is the PCT international filing date. The date of actual entry into the national stage is otherwise the date provided in the PALM system. Any issued patent will have all of the relevant dates listed.

Accordingly, no action is required regarding applicants' request to correct the filing date.

### CONCLUSION

For the reasons set forth above, applicants' request for corrected filing receipt is **GRANTED-IN-PART** to the extent that the title will be changed as requested.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of this letter marked to the attention of the Office of PCT Legal Administration.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations for issuance of a corrected filing receipt with the title changed to -- COMMUNICATION TERMINAL APPARATUS, BASE STATION APPARATUS AND RADIO COMMUNICATION METHOD--.



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